UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,979	07/20/2001	David Frederick Bantz	YOR920010525US1	2466

			EXAMINER
7590	12/03/2004		BARNIE, REXFORD N

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ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/910,979	BANTZ ET AL.
		Examiner	Art Unit
		REXFORD N BARNIE	2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>07 October 2004</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-69</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-69</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

REXFORD BARNIE
PRIMARY EXAMINER

Attachment(s)
1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-11, 21-24, 28-33, 35-38, 47-54, 56-59 and 68-69 are rejected

under 35 U.S.C. 102(e) as being anticipated by Rosenberg et al. (US Pat# 6,628,934).

Regarding claim 1, Rosenberg teaches a data network through which a user of a

mobile device can register and subscribe to desired services and then be billed based

on geographical area (location) where the services are to be used by the mobile phone

in (see col. 1 lines 8-11, col. 7 lines 6-32, col. 8 lines 19-23).

Rosenberg teaches determining a rate which according to applicant's disclosure

in (see page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Regarding claims 2 and 29, Rosenberg teaches billing a mobile client for

services in part based on geographic location where services are to be implement.

Regarding claims 3, 4, 11, 30 and 31, Rosenberg teaches an on-site support

system and software installation in (see fig. 4). Furthermore, a data processing system

including an internet is taught by Rosenberg.

Regarding claim 5, Rosenberg teaches a data processing system comprising a method for receiving a request fro service(s), identifying a location of the client in response to given location information and billing the client based on the location of where the client is to use the mobile phone in (see col. 1 lines 8-11, col. 7 lines 6-32, col. 8 lines 19-23). Rosenberg teaches determining a rate which according to applicant's disclosure in (see page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Regarding claims 6, 8-10, 33 and 35-38, Rosenberg teaches in general, a geographical location which would read on customer premise and then informing a user if a requested service cannot be provided in a geographical area in (see col. 12 lines 1-9).

Regarding claims 21-22, Rosenberg teaches a data processing system comprising a method for receiving a request fro service(s), identifying a location of the client in response to given location information and billing the client based on the location of where the client is to use the mobile phone in (see col. 1 lines 8-11, col. 7 lines 6-32, col. 8 lines 19-23). Rosenberg teaches determining whether a requested service can be provided based on the location identifier given in (see col. 12). Rosenberg teaches determining a rate which according to applicant's disclosure in (see page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Regarding claims 23-24, Rosenberg teaches a data processing system including a network and a server which includes a billing system and receives location information

to process request from a wireless device in (see fig. 4). Rosenberg teaches

determining a rate which according to applicant's disclosure in (see page 12 lines 18-

23) could be a fee in (see col. 6 lines 56-58).

Regarding claims 28 and 32, Rosenberg teaches a data processing system

comprising a method for receiving a request fro service(s), identifying a location of the

client in response to given location information and billing the client based on the

location of where the client is to use the mobile phone in (see col. 1 lines 8-11, col. 7

lines 6-32, col. 8 lines 19-23). Rosenberg teaches determining whether a requested

service can be provided based on the location identifier given in (see col. 12).

Rosenberg teaches determining a rate which according to applicant's disclosure in (see

page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Regarding claims 47-48, Rosenberg teaches a data processing system

comprising a method for receiving a request fro service(s), identifying a location of the

client in response to given location information and billing the client based on the

location of where the client is to use the mobile phone in (see col. 1 lines 8-11, col. 7

lines 6-32, col. 8 lines 19-23). Rosenberg teaches determining whether a requested

service can be provided based on the location identifier given in (see col. 12).

Rosenberg teaches determining a rate which according to applicant's disclosure in (see

page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Regarding claim 49, see the explanation as set forth regarding claim 1 because

the steps would inherently be performed based on software codes or instructions.

Rosenberg teaches determining a rate which according to applicant's disclosure in (see

page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Regarding claims 50-52, Rosenberg teaches the claimed limitations in (see

disclosure).

Regarding claim 53, see the explanation as set forth in the rejection of claim 5

because the steps would inherently be performed based on software codes or

instructions. Rosenberg teaches determining a rate which according to applicant's

disclosure in (see page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Regarding claims 54 and 56-59, Rosenberg teaches the claimed limitations.

Regarding claims 68-69, see the explanation as set forth regarding claim 47

because the steps would inherently be performed based on software codes or

instructions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 12, 39 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rosenberg in view of Linkola et al. (US Pat# 6,708,033).

Regarding claims 12, 39 and 60, Rosenberg fails to teach using location

information or identifier as part of updating a user's services including GPS as taught in

(see title, col. 8 lines 40-45) of Linkola.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to incorporate the teaching of Linkola into that of

Rosenberg thus making it possible to use any known location identification scheme in

identifying a calling party inorder to make a determination what services can be

provided to subscribers.

Claims 13-20, 40-46 and 61-67 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Rosenberg in view of Larkins (US Pat# 6,295,291) or Schuster et al.

(US Pat# 6,650,901).

Regarding claims 13, 40 and 61, Rosenberg fails to teach caller identification or

subscriber unit identification.

Shuster et al. teaches a system for providing user-configured telephone service

in a data network wherein local identification can be transmitted with a call in (see col.

14 lines 54-65).

Larkins teaches a setup of new subscriber radiotelephone wherein telephone

identification data can be transmitted in (see disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to incorporate the teaching of Linkola or Shuster into that

of Rosenberg thus making it possible to program telephone with the right services

based on its request and identification.

Regarding claims 14-20, 41-46 and 62-67, The examiner takes official notice that

billing based on traffic, latency, bandwidth, time of day and so forth is notoriously well

for the purpose of providing incentive and billing based on actual services provided.

Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rosenberg et al. (US Pat# 6,628,934).

Regarding claims 25-27, Rosenberg teaches a data processing system

comprising a method for receiving a request fro service(s), identifying a location of the

client in response to given location information and billing the client based on the

location of where the client is to use the mobile phone in (see col. 1 lines 8-11, col. 7

lines 6-32, col. 8 lines 19-23). Rosenberg teaches determining whether a requested

service can be provided based on the location identifier given in (see col. 12).

Rosenberg teaches determining a rate which according to applicant's disclosure in (see

page 12 lines 18-23) could be a fee in (see col. 6 lines 56-58).

Rosenberg fails to teach a data processing system in detail to include a bus

system but the examiner takes official notice that it's well known to have a computer

system including a bus, memory, processing unit and so forth for implementation or

provision of telephone services. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to implement the teaching of

Rosenberg into any known computer structure for the purpose of being able to provide

telephone services.

Claims 7, 34 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rosenberg et al. (US Pat# 6,628,934).

Regarding claims 7, 34 and 53, Rosenberg teaches that users would be billed in

part based on services and geographical information in (see disclosure) and therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was

made that different users will be billed different rates based on different geographical

locations and interconnections since all users will not be in the same location which can

be used in providing incentives and if needed, billing users higher rates for instance in

case where a user may be roaming.

Response to Arguments

Applicant's arguments filed on 10/07/04 have been fully considered but they are

not persuasive.

The applicant argued that Rosenberg fails to teach determining a rate for

charging.

The examiner disagrees because Rosenberg teaches determining a rate which

according to applicant's disclosure in (see page 12 lines 18-23) could be a fee in (see

disclosure for example col. 6 lines 56-58 of Rosenberg).

The applicant argued that the combination as set forth in the combination fails to teach the claimed subject matter in (see pages 19-20).

The examiner disagrees because the applicant has attacked the references individually when the explanation as set forth was based on a combination of references. Determining the location of a user for billing purposes is well known including roaming, using ANI (originating +terminating number) for billing purposes.

The applicant argued that subscription computing service is not taught by Rosenberg.

The examiner disagrees because (fig. 4) teaches a system wherein a user can subscribe to services to be used for subsequent calls or associated with one's terminal.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **REXFORD N BARNIE** whose telephone number is (703)306-2744. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CURTIS KUNTZ can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

PRIMARY EXAMINER
REXFORD BARNIE
11/29/04

REXFORD BARNIE
PRIMARY EXAMINER